

Notice of Allowability	Application No.	Applicant(s)	
	10/075,171	DEMINT ET AL.	
	Examiner	Art Unit	
	Erica E Cadugan	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to SN 10/075171 (atty ref 998/41) filed 2/14/2002 and interview of 7/8/04.
2. ☒ The allowed claim(s) is/are 1-13.
3. ☒ The drawings filed on 18 March 2002 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>6/25/02</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT and RESTRICTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 13, drawn to an apparatus, classified in class 409, subclass 138.
 - II. Claims 14 – 18, drawn to a method, classified in class 264, subclass 2.7.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process, such as one that does not orient the optical disk with reference to a particular point.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation between Examiner Michelle Lazor with Thad Adams on 5/19/04 a provisional election was made without traverse to prosecute invention I, claims 1 – 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14 – 18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER'S AMENDMENT

6. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Thad Adams on July 8, 2004.

The application has been amended as follows:

In claim 12, line 1, "claim 9" has been changed to --claim 1--.

In claim 13, line 1, "claim 9" has been changed to --claim 12--.

Non-elected claims 14-18 have been canceled.

7. The following is an examiner's statement of reasons for allowance:

U.S. Pat. No.'s 5,882,555 to Rohde et al., 6,612,789 to McKenzie, and 5,108,789 to Michael et al. are representative of the closest prior art of record to the present invention as set forth in independent claim 1.

Note that Rohde et al. teaches an optical disk profiling apparatus including an optical disk supply (including 182, 136, etc., see Figure 6), a moveable work table that moves relative to a stationary profiling tool (see col. 4, lines 7-9). Additionally, it is noted that while Rohde is silent as to any particular "accumulating assembly", the profiled disks must inherently be put

somewhere upon completion of their profiling, which “somewhere” is considered an “accumulating assembly”.

However, firstly, Rohde et al. does not make mention of any reciprocation of the workholding device between “loading” and “profiling” positions as claimed. Secondly, it is noted that Rohde does not teach that the device on which the workpiece is mounted is a “turntable”. Note specifically that even through Rohde specifies that the movement of the tool and the workpiece may be reversed such that the workpiece “moves about” the stationary tool (col. 4, lines 7-9), this is not sufficient to establish the workpiece mount as a “turntable” since it is unknown from the teachings of Rohde whether this “movement about” the tool is any sort of “turning” movement (or whether it is instead a series or multi-dimensional linear movements for example). Furthermore, even though Rohde does teach the use of a vacuum arm 188 that moves CD’s from 182 to a labeler (Figure 6 and col. 4, line 50+), Rohde is silent about whether or not any “pickup assembly mounted for rotation on a shaft between a plurality of positions under automated control of an electronic controller” is used for “(i) applying a lifting force to an optical disk on the optical disk supply assembly for removing an optical disk from the supply assembly; (ii) moving the optical disk to the turntable and interrupting the lifting force to place the optical disk on the turntable; (iii) applying a lifting force to the profiled optical disk to remove it from the turntable; and (iv) moving the optical disk to the profiled optical disk accumulating assembly for storage” as set forth in independent claim 1, and is indeed silent about the particular relative locations of the “supply assembly”, the “turntable”, and the “disk accumulating assembly”, and how the CD’s are transferred therebetween.

For at least the foregoing reasoning, Rohde does not anticipate the present invention as set forth in independent claim 1.

Additionally, there is no combinable teaching in the prior art of record that would reasonably motivate one having ordinary skill in the art to so modify the teachings of Rohde et al., and thus, for at least this reasoning, Rohde et al. does not render obvious the present invention as set forth in independent claim 1.

Regarding McKenzie, McKenzie teaches a CD profiling device wherein a plurality of CD's are transferred simultaneously from supplies 16 of disks (Figure 5A) to a position where each of these CD's are held fixed (both linearly and rotationally) so that they are all simultaneously machined by a respective 3D router 12 (see Figure 4, noting that all routers are mounted to a single mounting plate 33 for simultaneous movement), and then the CD's are simultaneously moved by a further pick-up assembly to a respective "disk accumulator" 52 (see Figure 8a).

Firstly, note that the disks are not mounted on any sort of "turntable", much less one that is used "for reciprocating between an optical disk loading position and an optical disk profiling position" as claimed in claim 1. Secondly, note that there is no "pickup assembly mounted for rotation on a shaft between a plurality of positions under automated control of an electronic controller" that is used for "(i) applying a lifting force to an optical disk on the optical disk supply assembly for removing an optical disk from the supply assembly; (ii) moving the optical disk to the turntable and interrupting the lifting force to place the optical disk on the turntable; (iii) applying a lifting force to the profiled optical disk to remove it from the turntable; and (iv) moving the optical disk to the profiled optical disk accumulating assembly for storage" as set

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forth in independent claim 1, and is indeed silent about the particular relative locations of the “supply assembly”, the “turntable”, and the “disk accumulating assembly”, and how the CD’s are transferred therebetween.

For at least the foregoing reasoning, McKenzie does not anticipate the present invention as set forth in independent claim 1.

Additionally, there is no combinable teaching in the prior art of record that would reasonably motivate one having ordinary skill in the art to so modify the teachings of McKenzie, and thus, for at least this reasoning, McKenzie does not render obvious the present invention as set forth in independent claim 1.

Additionally, regarding Michael et al., Michael teaches a method for manufacturing disk-shaped recording media (see title and abstract). The device includes a rotary spindle or “turntable” 7 to which a workpiece 15 being machined is affixed via vacuum chuck 8 (see Figure 1, for example). Also note that cutting tool 5 is guided radially across the workpiece surface to remove a thickness thereof (col. 2, lines 48-54). In operation, tongs 12 of gripper arm 11 of robot 10 is pivoted about a vertical axis to retrieve an unmachined workpiece blank 15 from a magazine or “optical disk supply assembly for holding a supply of optical disks to be profiled” 14 (Figure 4, col. 2, lines 30-45, for example). The robot then places the blank 15 in a position to be gripped by the spindle 7 for machining (col. 2). After machining is completed, the robot pivots about the same vertical axis to retrieve the machined blank 15’ and place it in a second magazine or “profiled optical disk accumulating assembly” 13 (Figure 4, col. 2, line 60 through col. 3, line 5, for example). Thus, the robot constitutes the claimed “pickup assembly”.

However, it is noted that firstly, Michael is surfacing the workpieces rather than profiling the edges thereof. Secondly, it is noted that the spindle or “turntable” 7 is not used for, nor does it appear to be capable of being used for “reciprocating between an optical disk loading position and an optical disk profiling position” as claimed. Instead, it is noted that the location of the spindle 7 shown in the Figures appears to constitute both the “loading” and the machining positions.

For at least the foregoing reasoning, Michael et al. does not anticipate the present invention as set forth in independent claim 1.

Additionally, even assuming *arguendo* that Michael’s tool is capable of being used to perform a profiling operation on the edge of the disk workpieces, there is no teaching in the prior art that would reasonably motivate one having ordinary skill in the art to modify the spindle or “turntable” 7 of Michael such that there were separate “loading” and “profiling” positions between which the spindle or “turntable” 7 was capable of or was used for “reciprocating” between the two positions.

Thus, for at least the foregoing reasoning, Michael, and thus the prior art of record as a whole, does not render obvious the present invention as set forth in independent claim 1.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

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Oath/Declaration

8. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required (or a supplemental application data sheet). See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

It is noted that an Application Data Sheet (ADS) was filed with the application, which ADS does identify the post office address, but which ADS does not serve to overcome the deficiencies of the oath/declaration, because it does not identify the residence of each inventor either.


Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E Cadugan whose telephone number is (703) 308-6395. The examiner can normally be reached on M-F, 7:30 a.m. to 5:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadugan
Primary Examiner
Art Unit 3722